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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,552	08/07/2003	Satoshi Matsuhashi	520.43016X00	8618
24956 7590 07/31/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER GAUTHIER, GERALD	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,552

Applicant(s)

MATSUHASHI ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on August 7, 2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. **Claim(s) 1-3, 10 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyauchi et al. (US 2003/0002637 A1) in view of Kobayashi (US 6,954,632 B2).

Regarding **claim(s) 1**, Miyauchi discloses a telephone applicable to a public switched telephone network (PSTN) and an Internet Protocol network (paragraph 0001), comprising:

a first interface for transmitting and receiving analog signals over the PSTN (1100 on FIG. 3);

a second interface for transmitting and receiving packet data over the IP network (5000 on FIG. 3);

means for communicating with a telephone number translation server connected to the IP network through said second interface when a call is originated by entering a PSTN telephone number (paragraph 0158);

means for communicating with a call agent connected to the IP network through said second interface to obtain IP address information of the destination telephone corresponding to said IP network telephone number, and establishing call connection with the destination telephone via the IP network by using the IP address information (paragraph 0158); and

means for establishing call connection with the destination telephone via the PSTN through said first interface if the IP network telephone number of the destination telephone corresponding to said PSTN telephone number cannot be obtained from said telephone number translation server (paragraph 0168).

Miyauchi fails to disclose obtaining from the telephone number translation server an IP network telephone number.

However, Kobayashi teaches obtaining from the telephone number translation server an IP network telephone number of a destination telephone corresponding to the PSTN telephone number (column 8, lines 15-21).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Miyauchi using the teaching of translating of telephone number as taught by Kobayashi.

This modification of the invention enables the system to obtain from the telephone number translation server an IP network telephone number so that the user would have the call connected to the home node.

Regarding **claim(s) 2**, Miyauchi discloses a telephone, further comprising means for communicating with said telephone number translation server and registering a mapping of the telephone's own PSTN telephone number and IP network telephone number to the server when the telephone is connected to the IP network (FIG.3).

Regarding **claim(s) 3**, Miyauchi discloses a telephone, wherein, if the entered PSTN telephone number consists entirely of local exchange code and subscriber number, said means for obtaining the IP network telephone number converts the entered PSTN telephone number into a numbering format including a toll number prior to obtaining the IP network telephone number of the destination telephone (paragraph 0158).

Regarding **claim(s) 10**, Miyauchi discloses a call connection control method for connecting a calling telephone, which is connected to a public switched telephone network and an Internet Protocol network, to a destination telephone (paragraph 0001), comprising the steps of:

communicating with a telephone number translation server connected to the IP network when a call is originated by entering a PSTN telephone number and obtaining

an IP network telephone number of the destination telephone corresponding to said PSTN telephone number (paragraph 0158);

obtaining IP address information of the destination telephone corresponding to said IP network telephone number from a call agent connected to said IP network and establishing call connection between the calling telephone and the destination telephone via the IP network by using the IP address information (paragraph 0158); and

establishing call connection between the calling telephone and the destination telephone via the PSTN if the IP network telephone number of the destination telephone corresponding to said PSTN telephone number cannot be obtained from said telephone number translation server (paragraph 0168).

Miyauchi fails to disclose obtaining from the telephone number translation server an IP network telephone number.

However, Kobayashi teaches obtaining from the telephone number translation server an IP network telephone number of a destination telephone corresponding to the PSTN telephone number (column 8, lines 15-21).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Miyauchi using the teaching of translating of telephone number as taught by Kobayashi.

This modification of the invention enables the system to obtain from the telephone number translation server an IP network telephone number so that the user would have the call connected to the home node.

Regarding **claim(s) 11**, Miyauchi discloses a call connection control method, further comprising the step of storing a mapping between the IP network telephone number obtained from said telephone number translation server and said PSTN telephone number into a cache table, wherein when a call is originated by entering a PSTN telephone number, said cache table is searched for the IP network telephone number of the destination telephone corresponding to the entered PSTN telephone number and, if the IP network telephone number of the destination telephone exists in the cache table, the IP network telephone number is used, if not, the IP network telephone number of the destination telephone is obtained from said telephone number translation server (paragraph 0158).

Response to Arguments

6. Applicant's arguments with respect to **claim(s) 1-3, 10 and 11** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/
Primary Examiner
Art Unit 2614

/GG/
July 23, 2007